

REMARKS

Claims 1-44 are pending. Claims 9-18, 20-24, and 26-44 stand withdrawn from consideration as being drawn to a non-elected invention/species, there being no allowable generic or linking claim. Claims 1-8, 19, and 25 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,023,688 to Ramachandran et al. Claims 1-2, 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,688 to Ramachandran et al. Claims 1-2, 4, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EPO 0 598 469. Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,269,348. Claims 3, 5-7, 19 and 25 are noted as being rejected only under 35 U.S.C. § 112, ¶ 2.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 1, 3, 5-6, 16, 19, 22, 24-25, and 28 are amended to clarify the invention. Claims 9-15, 17-18, 20-21, 23, 26-27, and 29-44 are canceled. Claims 1-8, 16, 19, 22, 24-25, and 28 remain in the case for consideration.

DOUBLE PATENTING REJECTION

A terminal disclaimer will be filed to overcome the obviousness-type double patenting rejection over U.S. Patent No. 6,269,348, once claim 1 is indicated as otherwise allowable.

REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

Claim 1 has been amended to remove the “such as” language. Claim 3 has been amended to connect the clearinghouse to the rest of the claim. Claim 3 is also rewritten in independent form, including all of the limitations of claim 1. Claims 5-6, 19, and 25 have been amended to eliminate the plural elements. Accordingly, claims 1-8, 19, and 25 should now be allowable over 35 U.S.C. § 112, ¶ 2.

As claims 3, 5-7, 19, and 25 were rejected only under 35 U.S.C. § 112, ¶ 2, claims 3, 5-7, 19, and 25 should now be allowable. Claims 16, 22, 24, and 28 are amended to depend from claim 3 and should be allowable with claim 3.

4/29/96

REJECTIONS UNDER 35 U.S.C. § 102(e)

The Examiner rejected claim 1 as being anticipated by U.S. Patent No. 6,023,688 to Ramachandran et al. However, claim 1 is supported by U.S. Patent No. 5,870,723, from which this invention claims priority. For example, the Examiner is referred to column 4, lines 18-58. The '723 patent describes a buyer registration step, wherein the buyer registers a biometric sample. A transaction step is proposed, wherein the buyer submits account information and a bid biometric sample. This transaction is transmitted to an identicator. The bid biometric sample is compared with a registered biometric sample to verify the transaction. Upon successful identification of the buyer, the transaction is processed. The Examiner is further referred to column 23, line 13, through column 24, line 31, where, among other embodiments, a retail point of sale terminal supporting such a transaction is described.

The only difference between the language of claim 1 and the description in the '723 patent is that the '723 patent does not expressly mention scrip. But, as described on page 1, line 31, through page 2, line 8, scrip is a medium of exchange that is honored by a merchant. As such, scrip is really nothing more than a form of cash, with the limitations that each variety of scrip is usable with only one Scrip Merchant, and that using scrip involves a Scrip Beneficiary. The use of scrip is functionally the same as cash, and therefore is supported by the specification of the '723 patent.

Since claim 1 is supported by the specification of the '723 patent, claim 1 is entitled to the priority date of the '723 patent, which is August 29, 1996. The '723 patent was filed before the priority date of Ramachandran. Therefore, Ramachandran is not available as reference under 35 U.S.C. § 102(e) over claim 1, and claim 1 is patentable over Ramachandran.

REJECTIONS UNDER 35 U.S.C. § 103(a)

With respect to the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,688 to Ramachandran et al., the Examiner is referred to the argument above, indicating that Ramachandran is not available as a reference under 35 U.S.C. § 102. As Ramachandran is not available as a reference under 35 U.S.C. § 102, Ramachandran is not available as a reference under 35 U.S.C. § 103(a), and cannot be used to reject claim 1.

With respect to the rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,688 to Ramachandran et al., the '723 patent supports the concept of multiple identicators. At column 33, lines 18-33, the Data Processing Center

(DPC) of the '723 patent is described. The DPC is the identifier of the invention. As the '723 patent describes “[e]ach DPC site . . .,” clearly there are multiple DPCs. As the use of multiple DPCs is to ensure reliable service, the DPCs are redundant, and each includes data that can be found in the other DPCs. Claim 2 is therefore supported by the specification of the '723 patent, and therefore is entitled to the priority date of the '723 patent, which is earlier than the priority date of Ramachandran. Accordingly, Ramachandran is not available as prior art to claim 2.

In addition, the Examiner indicated the use of a clearinghouse to collect scrip is old. But claim 2 makes no mention of a clearinghouse. Accordingly, the Examiner has failed to make a *prima facie* argument that claim 2 is unpatentable, and claim 2 should be allowable under 35 U.S.C. § 103(a) over Ramachandran.

With respect to the rejection of claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,688 to Ramachandran et al., both of these claims are dependent from claim 3. Claim 3 has not been rejected under either 35 U.S.C. §§ 102 or 103, and therefore is allowable. As claim 3 is allowable, all claims depending from claim 3 are allowable. This includes claims 4 and 8, and so claims 4 and 8 should be allowable under 35 U.S.C. § 103(a) over Ramachandran.

With respect to the rejection of claims 1-2 under 35 U.S.C. § 103(a) as being unpatentable over EP 0 598 469, the Examiner indicated the use of a clearinghouse to collect scrip is old. But claims 1-2 make no mention of a clearinghouse. Accordingly, the Examiner has failed to make a *prima facie* argument that claims 1-2 is unpatentable, and claims 1-2 should be allowable under 35 U.S.C. § 103(a) over EP 0 598 469.

In addition to the Examiner failing to make a *prima facie* argument that claims 1-2 are unpatentable under 35 U.S.C. § 103(a) over EP 0 598 469, EP 0 598 469 fails to make obvious the invention. As stated in claim 1, the invention performs *scrip supporter identification*. Identification involves using the bid biometric sample to identify the scrip supporter: in essence, to answer the question, “Who am I?” In contrast, EP 0 598 469 only teaches *verification*: that is, answering the question, “Am I who I say I am?” These are very different processes.

That EP 0 598 469 teaches verification and not identification can be found both directly and indirectly in the text. Column 7, lines 6-7 explicitly uses the word “verification.” In addition, the entire description of FIG. 2 (which perform the verification step) supports the assertion that EP 0 598 469 only teaches verification. Column 7, lines 35-36 describe FIG. 2 as teaching a way to “verify[] that the Issued [the person to whom the credit card was issued]

is placing the order.” Verification only requires comparing a proffered biometric against the biometric associated with the credit card, the objective being to answer the question “Does the proffered biometric match the biometric stored with the account?”. But identification requires comparing the bid biometric against many biometrics in the database, to see if there is *any* match. If a match is found, then the person is identified: if no match is found, then the person is *not* identified. Clearly, verification is a much simpler process than identification, and cannot make obvious identification from just a biometric.

The invention as defined by claim 1 is directed toward:

A method for tokenless authorization of an electronic scrip transaction using at least one scrip supporter biometric sample and an electronic identicator, said method comprising the steps of:

a. a scrip supporter registration step, wherein a scrip supporter registers with an electronic identicator at least one registration biometric sample,

b. an electronic scrip transaction proposal step comprising an electronic scrip donator account data,

c. at least one transmittal step, wherein a scrip supporter bid biometric sample is obtained from the scrip supporter’s person and is electronically transmitted to the electronic identicator,

d. a scrip supporter identification step, wherein *the electronic identicator compares the bid biometric sample with at least one registration biometric sample for producing either a successful or failed identification of the scrip supporter,*

wherein upon successful identification of the scrip supporter, a scrip transaction is biometrically authorized, without the scrip supporter presenting any smartcards or magnetic swipe cards.

(claim 1; italics added). As these features are not taught or suggested by EP 0 598 469, claim 1 is patentable under 35 U.S.C. § 103(a) over EP 0 598 469. Accordingly, claims 1-2, 19, and 25 are allowable.

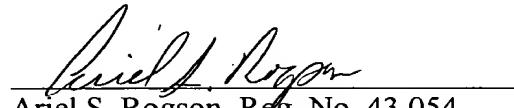
With respect to the rejection of claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over EP 0 598 469, both of these claims are dependent from claim 3. Claim 3 has not been rejected under either 35 U.S.C. §§ 102 or 103, and therefore is allowable. As claim 3 is allowable, all claims depending from claim 3 are allowable. This includes claims 4

and 8, and so claims 4 and 8 should be allowable under 35 U.S.C. § 103(a) over EP 0 598 469.

Applicant respectfully submits that each of the Examiner's rejections has been overcome and that this Application is in condition for allowance. Such is respectfully requested.

Respectfully submitted,

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